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EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/737,912

Applicant(s)
Karas et al.

Examiner
Cuong H. Nguyen

Art Unit
3625

K

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jan 8, 2002

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-28 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: _____

Status of the Claims

1. This Office Action is the answer to the communication received on 1/08/2002 (the Request to Rescind previous non-publication request).
2. Claims 1-28 are pending in this application.

Drawings

3. This application has been filed with informal drawings which currently are acceptable for examining purposes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **In general, claims 1-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tackbary et al. (US Pat. 5,960,412), (or Simpson - US Pat. 6,453,300), in view of McGurl et al. (US Pat. 5,893,080) (or in view of Kim et al., - US Pat. 5,299,295), and Lagin (US Pat. 3,783,755). In particular, each claim is rejected below within appropriate references (as listed above) depending on claimed specific limitations.**

Claims 17-28 are system claims; they are analyzed below. Claims 1-16 contain analogous features to claims 17-28, although they are method claims; therefore, similar rationales & references for rejections on 35 USC 103(a) are applied.

A. Re. to claim 17: **Tackbary et al.**, or **Simpson** (US Pat. 6,453,300)

teaches in their summary of inventions about:

A system to order and deliver a customized greeting message,
comprising:

(a) means for selecting a graphic image for inclusion in the message (this is equivalent to a computer I/O device for selecting; i.e., a keyboard or a mouse that goes with a computer; this feature is old and well-known (see **Simpson** (US Pat. 6,453,300), Fig.7; or see **Tackbary et al.**, 9:36-40);

(b) means for specifying customized text for inclusion in the message (i.e., a computer I/O device for selecting/input; i.e., a keyboard that goes with a computer for inputting data; this feature is old and well-known, see **McGurl et al.**, or see **Simpson** (US Pat. 6,453,300), Fig.7);

(e) means for printing the messages and a negotiable payment instrument (see **McGurl et al.**, Figs. 1-2 and 4:45-64; or **Simpson** (US Pat. 6,453,300), Fig.10; or see **Tackbary et al.**, 9:36-40; 13:16-20); it is equivalent to a computer I/O device i.e., a printer that goes with a computer; this feature is old and well-known); and

(f) means for mailing the message and "extra attachments" (i.e., a negotiable payment instrument), (see **McGurl et al.** 4:59-64, or **Tackbary et al.**, 9:36 – 50; 13:16 – 20), or **Simpson** (US Pat. 6,453,300), 12: 3-15 "... includes the insertion of names and other references..." to a recipient (this feature is old and well-known using an email interface and the Internet);

Tackbary et al., or **Simpson** does not disclose that a negotiable payment is included in said message.

However, the examiner submits that the following claimed means would be obvious with **McGurl et al.** (or **Kim et al.**'s systems:)

(c) means for specifying a payee for the negotiable payment (see **McGurl et al.**, 4:45-59); and

(d) means for selecting the monetary value of the negotiable payment; (see **McGurl et al.**, claim 21 (i.e., "generating payment disbursement data based upon a request"), (the examiner submits that these references also show that part (d) of this claim is obvious e.g., see **Kim et al.** 1:13-65, 3:59 to 4:4, or see **Tackbary et al.**, 6:11- 17, 11:59 to 12:10, or see **Simpson** (US Pat. 6,453,300) 5:5-22).

These limitations are not inventive features because these claimed means are merely means to create/select specific information that would be included in attached messages (e.g., means for specifying a name (see **Simpson** (US Pat. 6,453,300), Figs. 5, 7), and means for selecting a money amount from stored database; these would be done with a keyboard or a mouse that goes with a computer).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement **Tackbary et al.**, or **Simpson** (US Pat. 6,453,300) suggestions by adding extra specific information as **McGurl et al.** disclosure (see also **Simpson** (US Pat. 6,453,300) Fig. 7) as claimed above since extra information/attachment as claimed just increase a degree of clarity of

ordering and delivery a specific message on a network (from merging different data: a check and extra information) as in pending claim 17. The claimed limitations are also obvious with **Cahill et al.** (US Pat. 5,940,844) (the examiner not relied upon this invention yet to make this rejection) where in this patent discloses that a check is merged into a document 7:57 to 8:5 and 52:5-14).

B. Regarding claims 1, 2, 6-7: They are method claims that contain equivalent features to a use of an apparatus of claim 17; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

C. Re. to claim 20: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

In addition, the examiner submits that means for selecting the occasion for sending an email message is obvious (e.g., see **Tackbary et al.**, Figs. 4, 8; see **Simpson** (US Pat. 6,453,300), Figs. 6-7 about Christmas Holiday, New Year Holidays, Mother Day, Father Day, Valentine Day occasions .etc., or see **Simpson** (US Pat. 5,954,194) in the summary, disclosing "In the past, numerous cards, such a greeting or special occasion cards, have been available in a variety of shapes and sizes and with a variety of different decorative images, indicia and/or messages thereon").

D. Regarding claims 2, 7: They contain features that are equivalent to a use of an apparatus of claim 20; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

E. Re. to claim 18: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that **Tackbary et al.**, or **Simpson** (US Pat. 6,453,300) suggests a means for displaying an input form (i.e., a computer monitor) (see **Tackbary et al.**, Fig.6a, the summary of the invention; or **Simpson** (US Pat. 6,453,300), Figs. 6, 8).

F. Regarding claim 3: It contains features that are equivalent to a use of an apparatus of claim 17; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

G. Re. to claim 19: The rationales and reference(s) for 35 USC 103(a) rejection of claim 18 are incorporated.

The examiner submits that **Tackbary et al.**, or **Simpson** (US Pat. 6,453,300) suggests input information are customized/modifiable using a keyboard or a mouse that goes with a computer (see **Tackbary et al.**, Fig.6a, the summary of the invention – obviously, a specific software is used to perform **Tackbary et al.**'s invention, or **Simpson** (US Pat. 6,453,300), Fig.7).

H. Regarding claim 4, 9-10: They contain features that are equivalent to a use of an apparatus of claim 19; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

I. Re. to claim 21: The rationales and reference(s) for 35 USC 103(a) rejection of claim 20 are incorporated.

The examiner submits that **Tackbary et al.**, or **Simpson** (US Pat. 6,453,300) suggests that graphic image and customized text could be pre-selected (see **Tackbary et al.**, Figs. 4, 6a, the summary of the invention, a

customer may pre-select available image/text or customized image/text for a proper occasion (see **Tackbary et al.**, Figs. 4, 8); or **Simpson** (US Pat. 6,453,300), Fig. 7, or see **Simpson**, (US Pat. 5,954,194) in the summary, disclosing "In the past, numerous cards, such a greeting or special occasion cards, have been available in a variety of shapes and sizes and with a variety of different decorative images, indicia and/or messages thereon").

One of ordinary skill in the art would combine **Tackbary et al.**, and **Simpson** suggestions to appreciate that more flexibility of a document's content is given to a customer before sending a message.

J. Re. to claim 22: The rationales and reference(s) for 35 USC 103(a) rejection of claim 21 are incorporated.

The examiner submits that **Tackbary et al.**, or **Simpson** (US Pat. 6,453,300) suggests input information i.e., graphic image and customized text are modifiable by selections (see **Tackbary et al.**, Figs. 4, 6a; or **Simpson** (US Pat. 6,453,300), the summary of the invention). One of ordinary skill in the art would appreciate that more flexibility is given to a customer in sending a message's content.

K. Regarding claims 8, 10: They contain features that are equivalent to a use of an apparatus of claim 22; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

M. Regarding claims 4, 10: They contain features that are equivalent to a use of an apparatus of claim 19; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

N. Re. to claim 23: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that a combination of **Tackbary et al.**, & **McGurl et al.** (US Pat. 5,893,080 - Fig.1, ref. 30) suggests means for displaying a preview of the printed message and attached information (see also **Simpson** (US Pat. 6,453,300) Fig.9).

O. Regarding claim 11: It contains features that are equivalent to a use of an apparatus of claim 23; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

P. Re. to claim 24: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that **Tackbary et al.**, combines with **McGurl et al.** (Fig.2, ref.66 for changing a disbursement date) would be obvious to suggests means to specify a delivery date (by input a delivery date) for the message and negotiable payment instrument (e.g., payment would be in personal check .etc.).

Q. Regarding claim 12: It contains features that are equivalent to a use of an apparatus of claim 19; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

R. Re. to claims 25, 13: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that **Tackbary et al.**, or **Simpson** (US Pat. 6,453,300) would suggest that the recipient and the payee are the same, e.g., a

C.O.D. feature (see **Tackbary et al.**, or **Simpson** (US Pat. 6,453,300), the summary of the invention).

S. Regarding claim 13: It contains features that are equivalent to apparatus claim 25; therefore, it is rejected on 35 USC 103(a) with similar rationales and references set forth.

T. Re. to claims 26, 5, 14: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that the recipient and the payee can be different (see **Simpson** (US Pat. 6,453,300), Fig.7, 10:7- 30) (e.g., one can send an email to a receiver, and also send the same email to a payee).

U. Regarding claim 5, 14: They contain features that are equivalent to a use of an apparatus of claim 26; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

V. Re. to claims 27, 15: The examiner submits that information (e.g., negotiable payment instrument) can be an attachment of a message (e.g., see a pay stub perforated to a pay check, US Pat. 3,783,755, Figs. 1-2).

X. Regarding claim 15: It contains features that are equivalent to a use of an apparatus of claim 27; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

Y. Re. to claim 28: **It is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tackbary et al. (US Pat. 5,960,412), (or Simpson - US Pat. 6,453,300), in view of McGurl et al. (US Pat. 5,893,080) (or in view of Kim et al., - US Pat. 5,299,295), and further in view of Labin (US. Pat. 3,783,755).**

The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that information (e.g., a message & a negotiable payment box) could be printed on the same paper form (for perforating – claim 27 analogously comprises this feature - e.g., a pay stub perforated to a pay check, see **Lagin**, Figs. 1-2).

It would be obvious for one with ordinary skill in the art to combine Tackbary et al., **Simpson** (US Pat. 6,453,300), McGurl et al. with an idea of Lagin because all above applications are directed toward distributing a document, and doing perforation for such a document would be convenient in printing and saving paper's space.

Z. Regarding claim 16: It contains features that are equivalent to a use of an apparatus of claim 28; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

Conclusion

5. Claims 1-28 are not patentable.

6. The attached prior art are pertinent to claimed subject matter of this pending application:

- **Cahill** et al. (US Pat. 5,940,844) where in this patent discloses that a check is merged into a document 7:57 to 8:5 and 52:5-14).

- **Lagin** (US Pat. 3,783,755 – 1/08/1974), Apparatus for applying indices to sheets wherein this patent obviously comprises pending claims' 27-28 features.

- **Dotson et al.**, (US Pat. 5,029,901 – 7/09/1991), Confidential Information

bearing article wherein this patent obviously comprises pending claims' 27-28 features (see Figs. 2-3).

- **Kim et al.**, (US Pat. 5,299,295 – 3/29/1994), Method and apparatus for electronically viewing, printing, and registering checks.

- **Simpson; William S.** (US Pat. 6,453,300 - published on September 17, 2002), teaches a personalized greeting card with electronic storage media and method of personalizing same; wherein a first person can produce a customized gift for a second person; obtaining data from the first person which relates to the second person (i.e., sender's information); using the data to generate a customization code; providing the gift and the customization code to the second person; causing the control program to request the customization code from the second person (i.e., receiver's information); and using the customization code to select information from the non-customized information to provide a customized display to the second person. The gift is preferably purchased and customized through an Internet website (Filed: August 19, 1999; Current U.S. Class: 705/26.

- **Tackbary, et al.** (US Pat. 5,960,412 - published on September 28, 1999) teach a method and an apparatus for communicating with a card distribution center for management, selection, and delivery of social expression cards; wherein a customer can communicate to a card distribution center for selecting, ordering, and sending social expression cards using a personal computer. The user can enter names and addresses of card recipients into the system wherein the information is maintained in a database. The system displays digitized images of

the cards on a display screen which are retrieved from a card database. From the cards displayed, the user can select cards for designated recipients and enter personalized messages and a digitized signature (this can be a preview feature). The user may then send the order to a card distribution center, which processes the order, retrieves and prints the selected card images, including any user messages or user signature, and mails the cards to designated recipients or customers. The system maintains a database of all recipients, addresses, associated occasions and dates, card preferences, relationships and order history (Filed: September 6, 1996, Current U.S. Class: 705/27; 700/233; 700/235; 705/26).

- William E. Simpson, (US Pat. 5,954,194 published on September 21, 1999, discloses a gemstone gift card with video or audio device carrier (Filed: December 10, 1997 - Current U.S. Class: 206/96).

- **West**; James H. US Pat. 6,011,833 - January 4, 2000, teach a talking bouquet, wherein a service enabling a sending party to arrange through use of an organization offering this service for physical delivery of a gift such as a bouquet of flowers to a receiving party, the gift being accompanied by a card (analogous to an attachment in this pending application) which directs the receiving party to receive by telephone a recorded personalized message from the sending party (this would be analogous to a printed customized message about information containing a sender/a receiver, detailed information e.g., payment .etc.), (Filed: August 11, 1998 - Current U.S. Class: 379/88.25).

- **Milton E. Vallaire**, (US Pat. 5,971,273 published on October 26, 1999),
discloses an automated florist system allowing direct contact with delivering
florist, containing an order taking control unit for automated vending and order
placements specifically for flowers and gift items. The system allows a customer
to select from a variety of pre-made flower arrangements (this is analogous to a
subject matter of customized messages on a printed card) from discrete cells
equipped with the necessary refrigeration for immediate purchase, or,
alternatively, a selection may be made, and information entered, for remote
delivery at a specified time and place (note displayed "order form"). An order can
be done from a server sending of said order to an affiliated florist for a distant
delivery is fully automated (Filed: September 24, 1997, Current U.S. Class:
235/381).
- **Carlson et al.** (US Pat. 4,758,714), teach a computer system that let a
user to access & operate a negotiable instrument at a POS for an electronic fund
transfer.
- "Money Order Dispensing Boost Security", May 14, 1986, American Banker,
vol. 151, No. 95, Dialog file 625, Accession No. 0052059.
- **Jerry Lansky**, "Without APS, Photo Life Goes on Via Internet", Photographic
Trade News, p. 22, Aug. 1996.
- From <http://www.findarticles.com>, Bottom line Technologies launches Internet
Payment solution PayBase –Secure WebPay Series, Business Wire, 12/17/1998.
- From <http://www.findarticles.com>, PayMaxx launches POWERPayroll.com
version 3.0 – Business Wire, 9/15/2000.

- From <http://www.findarticles.com>, PayMaxx introduces PayView.com; Internet payroll pioneer offers customers another value-added tool – Business Wire, 1/06/2000.

- From <http://www.findarticles.com>, PayMaxx launches instant W-2; employees now able to retrieve replacement W-2s instantly via the Internet – Business Wire, 10/23/2000.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone number is 703-305-4553. The examiner can normally be reached on Mon.-Fri. from 7:00 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to: (703) 305-7687 *[Official communications]*

or 703-746-5572 (RightFax)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist with a telephone number: (703)308-1113.

Cuong H. Nguyen
Primary Examiner
August 18, 2003